

Application No. 10/502,028  
Amendment dated August 25, 2008  
Reply to Office Action of May 23, 2008

Docket No.: 65856-0062

**AMENDMENTS TO THE DRAWINGS**

The attached sheet(s) of drawings includes changes to FIGS. 2 and 5.

Attachment:      Replacement sheets

### **REMARKS**

Applicant has carefully reviewed the Office Action mailed April 23, 2007, and thanks Examiner for the detailed review of the pending claims. In response to the Office Action, Applicant has amended claims 1, 3, 7, 8, 12, 16 -18, 21, 22 and 27, and cancelled claims 2, 5, 6, 26 and 28. By way of this amendment, no new matter has been added. Accordingly, claims 1, 3, 4, and 7-25 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections.

As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Applicant respectfully requests reconsideration of the present application in view of the above amendment, and the following remarks.

### **New Claims**

New Claims 29 and 30 find support, at least, in page 12, line 1 to page 13, line 9 and FIGS. 5-10.

### **Drawings**

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference numerals 24 and 27. FIGS. 2 and 5 have been amended to

illustrate reference numerals 24 and 27. Accordingly, withdrawal of this objection is respectfully requested.

### **Claim Objections**

Claim 6 is objected to because of the following informalities: Applicant refers to “the carrier member ...” which does not find antecedent basis in the claims. Claim 6 has been canceled.

Claim 8 is objected to because of the following informalities: The applicant claims a “...traversing number ...” which is incorrect. Claim 8 has been amended to recite a “traversing member.”

Claim 22 is objected to because of the following informalities: Applicant recites the limitation “the distance ...” without providing sufficient antecedent basis. Claim 22 has been amended to provide proper antecedent basis for the term “distance.”

Accordingly, withdrawal of these objections is respectfully requested.

### **Claim Rejections – 35 USC §112**

Claims 1-25, 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant submits that the amendments presented herein correct the alleged deficiencies identified by the Examiner.

### **Double Patenting**

Claims 1, 6, 7, 17, 18, 21-24, 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/501,821. Since the rejection is only provisional Applicant will respond on the merits, if necessary, in due course.

**Claim Rejections – 35 USC § 102**

Claims 1, 2, 4-7, 15, 21, 26 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by Willford et al. (US Patent 5,566,579). Applicant respectfully traverses the rejection.

“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” *Celeritas Tech., Ltd., v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 [47 USPQ2d 1516] (Fed. Cir. 1998) cert. denied, 525 U.S. 1106 (1999)

Independent claim 1 positively recites “a traversing member located in the cassette housing and movable in a first orthogonal direction for selecting a shift rail, and a carrier member supported by the traversing member and moveable in a second orthogonal direction for axially moving a selected one of the shift rails.” Further, independent claim 27 recites “a traversing member located on the cassette housing and movable in the first orthogonal direction, the carrier member being supported by the traversing member and movable in the axial direction.” In contrast, Willford teaches a shift shaft 31 that axially moves in one orthogonal direction and **rotates** to shift a transmission, while not teaching both a traversing member and a carrier member for traversing movement. Thus, Willford does not teach every recitation of independent claims 1 and 27, as required in *Celeritas*.

Dependent claims, 2, 4-7, 15, and 21 are also patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested

**Claim Rejections – 35 USC § 103**

Claims 2-3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Willford et al. (US patent 5566579).

Claims 8-14, 17-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Willford et al., as applied in claims 1 and 6, and in view of Meyers et al. (US patent 4892001).

Claims 22-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Willford et al. in view of Okubo et al. (US patent 4608877).

Claim 28 was rejected under 35 U.S.C. 103(a) as being unpatentable over Willford et al. in view of Meyers et al. and Kagi (US patent 3572770).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of Willford to teach every element of independent claim 1 is also fatal to the §103 rejections. Additionally, Meyers, Okubo, and Kagi do not teach both a traversing member and a carrier member for traversing movement, and therefore, cannot make up for the inadequacy described above. Therefore, the §103 combinations cannot not teach every recitation of independent claim 1, as required in *In re Royka*. Furthermore, dependent claims, 2, 3, 8-14, 17-20, 22-24, being dependent upon independent claim 1, are patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **Conclusion**

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required

Application No. 10/502,028  
Amendment dated August 25, 2008  
Reply to Office Action of May 23, 2008

Docket No.: 65856-0062

in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 65856-0062 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: August 25, 2008

Respectfully submitted,

The 23rd falling on a Saturday

Electronic signature: /Kenneth W. Jarrell/  
Kenneth W. Jarrell

Registration No.: 52,484

Michael B. Stewart

Registration No.: 36,018

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 10291

Attorneys for Applicant

R0534056.DOC